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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,390

06/23/2003

Bradley Emalfarb

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER

BROWN, ALVIN L

ART UNIT

PAPER NUMBER

3622

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,390	<b>Applicant(s)</b> EMALFARB, BRADLEY	
	<b>Examiner</b> ALVIN L. BROWN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-20-2003; 06-23-2003</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following is a non-final, First Office Action on the merits. Claims 1- 22 are pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-13, 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Turnpike: Doing What It Does Best?, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike").**

**As per claims 1, 13,** Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support on or adjacent to a public right-of-way including at least one lane for vehicle traffic to move in a first direction and a second lane spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction (column 1, lines 25-40);

providing information pertaining to the public right-of-way on the support in a manner that the information is viewable by an occupant of a vehicle in the one lane moving in a first direction and facing generally in the first direction (column 1, lines 25-40);

Kalt does not explicitly disclose providing advertising information unrelated to the public right-of-way on the support so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction ; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity.

However, Turnpike discloses providing advertising information unrelated to the public right-of-way on the support so that the advertising information is viewable by an

Art Unit: 3622

occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction ; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity (page B 37, where two sided billboards offer advertisement for turnpike traffic at a cost to advertisers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Turnpike's two sided billboards with advertisements to Kalt's highway overpass traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

**As per claim 2**, Turnpike further discloses the step of providing advertising information comprises providing the advertising information on a substantially flat, first display surface facing in the first direction (page B37).

**As per claim 3**, Kalt further discloses the step of providing information pertaining to the public right-of-way comprises providing information pertaining to the public right-of-way on a substantially flat, second display surface facing oppositely to the first direction (column 1, lines 25-40).

**As per claim 4**, Turnpike further discloses the step of illuminating the advertising information (page B37).

**As per claims 5-8, 16-19**, Kalt further discloses the step of providing information pertaining to the public right-of-way comprises providing information pertaining to the public right-of-way on a first display surface that is on the support in an elevated position and at least partially directly over the one lane (column 1, line 64 - column 2,

Art Unit: 3622

line 16, the sign is disclosed to be mounted on overpasses of highways which is equivalent to at least one traffic lane).

**As per claims 9-12, 20-22**, Turnpike further discloses the step of providing information pertaining to the right-of-way comprises providing information pertaining to the right-of-way on a first display surface with a first area on the support, and the step of providing advertising information comprises providing advertising information on a second display surface with a second area on the support so that the first and second areas overlap both sideways and in a vertical direction (page B37).

**As per claim 15**, Kalt discloses there is a first shoulder region to a side of the first and second lanes opposite to the one side and the step of providing the second display system comprises providing the second display system at least partially directly over the first shoulder region (column 1, line 64 - column 2, line 16, where near the roadway is equivalent to shoulder region).

3. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Turnpike: Doing What It Does Best?, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike") further in view of Mudryk et al., (6,267,529).**

**As per claim 14**, the Kalt and Turnpike combination discloses the claimed invention as in claim 13. The combination does not disclose there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median.

However, Mudryk discloses there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median (column 1, lines 15-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mudryk's highway median sign to Kalt's highway traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/

Primary Examiner, Art Unit 3622